

REMARKS

This responds to the Final Office Action mailed on July 13, 2005 and the Advisory Action mailed September 30, 2005.

Claims 1, 5, 12, 16, 23, 27, 34 and 38 are amended; claims 45- 48 are new as a result, claims 1-48 are now pending in this application.

§102 Rejection of the Claims

Claims 1-3, 5-6, 9-14, 16-17, 20-25, 27-28, 31-36, 38-39 and 42-44 were rejected under 35 U.S.C. § 102(e) for anticipation U.S. 6,571,241 (hereinafter Nosohara).

Applicant respectfully submits that claims 1-3, 5-6, 9-14, 16-17, 20-25, 27-28, 31-36, 38-39 and 42-44 should not be rejected under 35 U.S.C. § 102(e) for the reason that Nosohara does not disclose each and every limitation of the claim 1 of the present application.

To anticipate a claim, the reference must teach every element of the claim.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Claim 1 includes the following limitation:

a predetermined question that is asked by said first entity and translated responsive to said selection by said first entity.

The Final Office Action contends that the above limitation is anticipated by the following disclosure in Nosohara:

On the displayed menu window 801, the user selects "Simple Search" 802 or "Expert Search" 803, designates an "Option" item, and inputs a search condition (step S204). The "Simple Search" is used to search for patent information stored in the database (115, 116, or 117) on the basis of an arbitrary English word input by the user, and has a menu layout as shown in FIG. 9A. The "Expert Search" is used to search for patent information stored in the database (115, 116, or 117) after the search range is narrowed down to, e.g., search for only an applicant designated by the user from patent applicants, and has a menu

layout as shown in FIG. 9B (emphasis added).

Col. 8, lines 36-48.

The above quote from Nosohara describes a menu window that includes a “Simple Search” and an “Expert Search.” A user may select the “Simple Search” to search for patent information based on a search condition which is comprised of arbitrary English words input by the user. The user may also select the “Expert Search” to search for patent information based on the search condition and a narrowed search range (e.g., designating an applicant, see Fig. 9B).

Claim 1 requires a predetermined question that is asked by a first entity and translated responsive to the first entity selecting the question. The specification includes an example question, “What is your address?” (Figure 3A), that may be translated to a preferred language (e.g., French, Italian, etc.) responsive to a user selecting the question.

In contrast to the limitations of claim 1, the above quote from Nosohara does not describe a predetermined question that is asked by a first entity and translated responsive to selection by the first entity; but rather, a user interface that enables a user to select a type of search (e.g., “Simple Search” or “Expert Search”) and performance of the selected search in response to the selection of the user. The above quote from Nosohara simply does not describe a translation of “Simple Search” in response to the user selecting “Simple Search” or a translation of “Expert Search” in response to the user selecting “Expert Search.” Indeed, the Final Office action, in paragraph 11, suggests that Nosohara may present “Simple Search” and “Expert Search” in different languages (e.g., “Japanese, English”).

Assuming that Nosohara does describe a presentation of “Simple Search” and “Expert Search” in different languages then such a presentation may not be said to be responsive to the selection of the user, as required by claim 1, because the presentation comes before the selection of the user.

Further, with all due respect, the Final Office Action alleges anticipation of claim 1 by inconsistently reading the “first entity” of claim 1. For example, the Final Office Action reads the “first entity” on the “user” in the above quote from Nosohara and also on the “information search apparatus” in another quote of Nosohara (Final Office Action paragraph 6, Col. 7, lines 33-37) suggesting that Nosohara does not anticipate the limitations of claim 1. Nosohara therefore cannot be said to anticipate the above quoted limitation because Nosohara describes a

user interface that enables a user to select a type of search and performance of the selected search in response to the selection of the user and claim 1 requires a predetermined question that is asked by a first entity and translated responsive to the first entity selecting the question.

In summary, Nosohara does not disclose each and every limitation of claim 1, as required to support a rejection of this claim under 35 U.S.C. § 102(e).

The above remarks are accordingly also applicable to a consideration of the independent claims 12, 23 and 34. Accordingly, Applicant requests that the above remarks and amendments contained herein also be considered when examining these other independent claims for allow ability.

As dependent claims are deemed to include all limitation of claims from which they depend, the rejection of claims 2-3, 5-6, 9-11, 13, 14, 16-17, 20-22, 24-25, 27-28, 31-33, 35, 36, 38-39 and 42-44 under 35 U.S.C. § 102(e) is also addressed by the above remarks, and the amendments contained herein.

§103 Rejection of the Claims

Claims 4, 7-8, 15, 18-19, 26, 29-30, 37 and 40-41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nosohara in view of U.S. 6,301,554 (hereinafter Christy).

Claims 4 and 7-8 depend on independent claim 1; claims 15, 18 and 19 depend on independent claim 12; claims 26, 29 and 30 depend on independent claim 23; and, claims 37, 40 and 41 depended on independent claim 34. As dependent claims are deemed to include all limitation of claims from which they depend, the rejection of claims 4, 7-8, 15, 18-19, 26, 29-30, 37 and 40-41 under 35 U.S.C. § 102(e) is also addressed by the above remarks, and the amendments contained herein.

In summary, Nosohara in combination with Christy does not teach or suggest each and every limitation of the independent claims as required to support rejections of the independent claims of the present application under 35 U.S.C. § 103.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney 408-278-4046 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop RCE, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 13 day of October, 2005.

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